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In re Application of: Wells Obrecht )  
Application No. 08/900,360 )  
Filed: July 25, 1997 ) **DECISION ON PETITION UNDER 37**  
For: METHOD AND APPARATUS FOR ) **C.F.R. § 1.181(a) TO INVOKE**  
PRODUCING GOODS IN AN ) **SUPERVISORY AUTHORITY**  
AUTOMATED MANNER )

This is a decision on a petition, filed 3 July 2001, under 37 C.F.R. § 1.181(a) to invoke Supervisory Authority requesting the Director to reverse the Primary Examiner's holding as to the Grouping of Claims under appeal as set forth in the Examiner's Answer (mail date 7 May 2001).

### OPINION

#### A. Reviewability of Propriety of Appeal Brief

37 C.F.R. § 1.181(a) states:

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

MPEP §1206 states in relevant part:

#### REVIEW OF BRIEF BY EXAMINER

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner. 37 CFR 1.192(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance

MPEP §1208 states in relevant part:

Briefs must comply with 37 CFR 1.192, and all examiner's answers filed in response to such briefs must comply with the guidelines set forth below.

(A) REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(7) Grouping of Claims. A statement of whether the examiner disagrees with any statement in the brief that certain claims do not stand or fall together, and, if the

examiner disagrees, an explanation as to why those claims are not separately patentable

Care must be taken to distinguish between the following situations:

**(a) No reasons supplied in Brief as to why Claims stand on their own**

In this case the Brief fails to meet the requirements of 37 C.F.R. §1.192(c)(7) and a Form PTO-462 "Notification of Non-compliance with 37 C.F.R. §1.192(c)" should be issued.

**(b) Reasons supplied in Brief which in examiner's view are inadequate to establish that the claims stand on their own.**

The brief complies. No reference to 37 C.F.R. §1.192(c)(7) is appropriate. The Examiner may address the *merits* of applicant's arguments in the Answer.

**DECISION**

The Examiner's answer acknowledges that Applicant has separately argued the novelty of claims 2-9. However, the Examiner disagrees with the grouping, reasoning that all arguments presented for these dependent claims were specifically argued in reference to independent claim 1. This response is in accord with MPEP §1208 (A)(7).

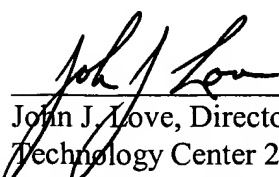
In this instance, Applicant disagrees with Examiner's position on the grouping of claims. This is an issue in the appeal subject to the determination of the Board of Patent Appeals and Interferences. Therefore, this is not proper subject matter for petition under 37 C.F.R. § 1.181(a).

Furthermore, a review of the Examiner's Answer reveals that the examiner has responded in detail to each and every argument presented by Applicant in the Appeal Brief. Thus, despite the Examiner's statement that the claims stand and fall together, the Examiner has treated each claim as separately argued.

The petition is **DENIED**

Applicant is advised that the Reply Brief affords Applicant the opportunity for contesting the position taken by the Primary Examiner in the Examiner's Answer.

The application file is being returned to the Board of Patent Appeals and Interferences where it will await a decision.

  
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